

## **REMARKS**

Careful consideration has been given to the Official Action of March 6, 2009 and reconsideration of the application is respectfully requested.

Claims 1, 4, 7-8, and 11-22 stand rejected under 35 USC 103(a) as being allegedly unpatentable over Rost (Patent No. 2, 123,746) in view of what the Examiner contends is Applicant's Own Admission of Prior Art (AOAPA).

Claim 23, as best understood by the Applicants, stands rejected under 35 USC 103(a) as being allegedly unpatentable over Chase (Patent No. 1,370,731) in view of AOAPA. This rejection is not clear because in item 7 of the Official Action, the Official Action cited Rost (but with Chase's Patent No) in the opening sentence, but referenced both Chase and Rost in the discussion that followed.

Claims 1 and 19 have been amended to recite that the insulating material holds the wires in the predetermined polygonal cross-section such that the conductor is shape-maintaining. This ties the functional limitation ("shape-maintaining") to the structure that carries out the function. Support for this can be found at, for example, page 4, lines 1-2 of the original specification.

The cited art does not set forth even a *prima facie* case of obviousness for at least two reasons:

- I. Neither Chase, Rost, nor AOAPA teaches or suggests the conductor maintaining its

polygonal shape unless or until the layer of insulating material is removed. And

II. There is no motivation for combining Rost or Chase with AOAPA as proposed by the Examiner.

Each of these two points will now be discussed in turn below.

With respect to point I above, the Examiner contends that there are no structural (as opposed to functional) limitations that distinguish the claimed invention from the cited art. However, where as here the claimed functional limitation defines structural attributes of the product, they must be considered. See MPEP 2173.05(g) (“A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.”) In the present case, the functional limitation dictates that the insulating material must have the structure (in combination with the other elements) to carry out the claimed function. See MPEP 2173.05 (g) (“In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).”)

The independent claims as now presented recite that the conductor is surrounded by a layer of an insulating material that holds the wires in the predetermined polygonal cross-

section whereby the conductor is shape-maintaining such that it maintains the predetermined polygonal cross-section unless and until the layer of insulating material is removed. Here, the limitation that the insulating material holds the wires in the predetermined polygonal cross-section whereby the conductor is shape-maintaining such that it maintains the predetermined polygonal cross-section unless and until the layer of insulating material is removed defines structural attributes of the claimed invention and must be evaluated and considered, just like any other limitation of the claims.

With respect to this limitation, it is respectfully submitted that the Examiner still fails to show how Chase, Rost, or AOAPA teaches or suggests the conductor maintaining its polygonal shape unless or until the layer of insulating material is removed. It is noted that the Examiner referenced Fig. 3 of Rost, but Fig. 3 merely shows the configuration of the high-tensile cable and do not show that the conductor is shape-maintaining. The Examiner also alleged that AOAPA teaches shape-maintaining because AOAPA teaches using the same diameter of flexible wires. However, one skilled in the art would clearly recognize that it is not the flexibility of the wires that provides the shape-maintaining. In fact, the flexibility of the wires is the reason for providing the shape-maintaining feature of the claimed invention so that the shape of the conductor can be maintained while providing flexibility since fine flexible wires cannot keep the shape themselves. Thus, it is respectfully submitted that the flexible wires of AOAPA do not teach or suggest the shape-maintaining feature of the claimed invention.

Chase is directed to cables for high-voltage power work in which the electrostatic

stresses and losses, electrodynamic losses, and heating are attained by winding around the insulation individual to the conductor or to each conductor, a conducting sheath, which is not intended primarily for mechanical protection, but for electrical and thermal purposes (see page 2, lines 21-39). Like Rost, and AOAPA, there is also nothing in Chase that would teach or suggest that the conductor is shape-maintaining such that it maintains the predetermined polygonal cross-section unless and until the layer of insulating material is removed.

Since none of the cited references teaches or suggests that a conductor of small, flexible wires of the recited configuration would be shape-maintaining, their combination cannot either. Therefore, Rost, AOAPA, and Chase, whether taken singly or in combination, do not teach or suggest every feature of the claimed invention and cannot support a *prima facie* case of obviousness.

In addressing point II above, the Examiner referenced MPEP 2114. However, it is respectfully submitted that MPEP 2114 does not deal with the issue of obvious to combine. The question at issue is whether one skilled in the art would combine the cited references with AOAPA in the manner proposed by the Examiner (and not how claim recitations should be interpreted).

One skilled in the art would not combine Rost with AOAPA because the proposed combination would render the prior art unsatisfactory for its intended purpose. See MPEP 2143.01 V. ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the

proposed modification.”) Rost is directed to insulating means for high tension conductors and cables. Substituting the high tension conductor with the fine flexible wires clearly would result in a cable that is unsatisfactory as high-tension conductors or cables. The reverse is also true, i.e. substituting the fine flexible wires of AOAPA with the high-tension conductors and cables would clearly result in a cable that is no longer flexible.

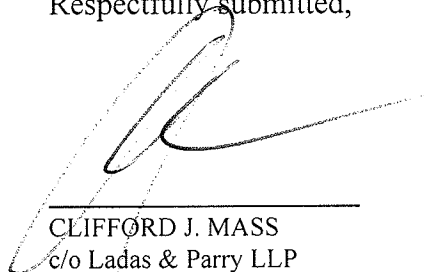
Similarly, Chase is directed to cables for high-voltage power work. One skilled in the art also would not combine Chase with AOAPA in the manner proposed by the Examiner for the same reason discussed in the preceding paragraph.

Furthermore, combining the cited references in the manner proposed by the Examiner would change the principle of operation of the cited references. See MPEP 2143.01 VI (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”)

Therefore, it is respectfully submitted that there would have been no motivation or reason to combine the cited references in the manner proposed by the Examiner and the references do not set forth a *prima facie* case of obviousness.

In view of the above comments, it is respectfully submitted that every rejection has been addressed and favorable reconsideration of the application is earnestly solicited.

Respectfully submitted,

A handwritten signature in dark ink, appearing to be "Clifford J. Mass", written over a horizontal line.

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